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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,270	03/21/2001	Peter Hans Edlund	34648-00446USPT P13307US	3974
27045	7590	01/10/2005	EXAMINER CHO, UN C	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR C11 PLANO, TX 75024			ART UNIT 2687	PAPER NUMBER

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,270

Applicant(s)

EDLUND ET AL.

Examiner

Un C Cho

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 6, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lupien (US 5,839,070).

Regarding claim 1, Lupien discloses a method in a telecommunications network for downloading information to a mobile station operating in a location area comprised of cells having a first communication system and neighboring cells having a second communication system (Col. 6, lines 1 – 15) comprising steps of receiving a registration procedure request from said mobile station within a cell in said location area having the first communication system (mobile station exchanging information, inherently registration procedure, and orders with the Base Station and MSC and has an opportunity through either cell reselection or hand-off to change the base station, Col. 6, lines 16 – 25), determining whether the selected mobile station is a multimode mobile station capable of communicating with both the first communication system and the second communication system (MSC detects whether the mobile station is multimode or single mode), responsive to the determination that the mobile station is a multimode mobile station, downloading a flag (downloading a list) to the

multimode mobile station to provide notice of a neighboring cell having a second communication system wherein notice of the second communication system is not provided to any single mode mobile stations (Lupien, Col. 8, lines 15 – 28).

Regarding claim 2, Lupien discloses said multimode mobile station commences measurements directed to second cell in response to said notice (mobile station measures neighboring cell signal strength, Col. 8, lines 1 – 9).

Regarding claim 5, Lupien discloses downloading a list of first cells, which respectively have second cell neighbors to the selected mobile station (Lupien, Col. 8, lines 24 – 28).

Regarding claim 6, Lupien discloses that the list is downloaded to the multimode mobile station in connection with a location area updating procedure that starts when the multimode mobile station enters the location area (Lupien, Col. 7, lines 46 – 57).

Regarding claim 10, Lupien discloses at least some of said information comprises intersystem cell reselection parameters, which are downloaded to said multimode mobile station by means of a MM specific procedure. (Lupien, Col. 7, lines 34 – 37 and 39 – 45).

Regarding claim 13, Lupien discloses said network downloads a list of neighboring cells in said location area to said multimode mobile station during a location updating procedure. (Lupien, Col. 7, line 66 – Col. 8, line 4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Tiedemann Jr. et al. (US 6,216,004).

Regarding claim 4, Lupien as applied to claim 1 above discloses downloading a neighbor list to mobile station. However, Lupien as applied to claim 1 above does not specifically disclose a flag comprising a single bit transmitted to selected mobile station by means of a BCCH carrier. In an analogous art, Tiedemann discloses a flag comprising a single bit transmitted to selected mobile station by means of a BCCH carrier (Tiedemann, Col. 21, lines 22 – 62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Tiedemann to the system of Lupien in order to provide a need for soft handoff on common channels, such as paging channel, in a cellular system.

5. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Moore (US 6,501,951).

Regarding claim 7, Lupien as applied to claim 1 above discloses supplying a list of first cells in the location area to the selected mobile station (Lupien, Col. 8, lines 24 – 28).

However, Lupien as applied to claim 1 above does not specifically disclose downloading a pointer to the selected mobile station to identify first cells on the list, which respectively have neighboring second cells. In an analogous art, Moore discloses downloading a pointer to the selected mobile station to identify first cells on the list, which respectively have neighboring second cells (Moore, Col. 4, lines 21 – 46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Moore to the system of Lupien in order to provide further controls in the re-selection process to avoid the attempt to re-select to incompatible control channels and also desirable to avoid second attempts to re-select to control channels which are determined to be incompatible with the mobile station during a re-select attempt.

Regarding claim 9, Lupien in view of Moore as applied to claim 7 above discloses transmitting a flag to said multimode mobile station (Moore, Col. 4, lines 21 – 46) to direct the said multimode mobile station to generate a download request message (Lupien, Col. 7, lines 46 – 57) and downloading information pertaining to said neighboring cell in response to the download request message (Lupien, Col. 8, lines 24 – 28).

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6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Moore as applied to claim 7 above, and further in view of Tiedemann Jr. et al. (US 6,216,004)

Regarding claim 8, Lupien in view of Moore as applied to claim 7 above do not specifically disclose transmitting a pointer to said multimode station by means of a BCCH carrier. In an analogous art, Tiedemann discloses transmitting a pointer (a flag) to said multimode mobile station by means of a BCCH carrier (Tiedemann, Col. 21, lines 22 – 62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Tiedemann to the system of Lupien in order to provide a need for soft handoff on common channels, such as paging channel, in a cellular system.

7. Claims 11, 12, 15, 16, 18, 19, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Korpela (WO 99/01005).

Regarding claim 11, Lupien as applied to claim 1 above does not specifically disclose first communication system comprises a Global System for Mobile communications (GSM) system and said second communication system comprises a Universal Mobile Telecommunications System. In an analogous art, Korpela discloses that the first communication system comprises the GSM (Fig. 2, 21a and 22a) and the second communication system comprises the UMTS (Fig. 2, 23a, 24a, 25a and 26a) (Korpela, Page 6, lines 10 – 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to provide the technique of Korpela to the system of Lupien in order to provide data transfer resources for finding a suitable new cell more efficiently.

Regarding claim 12, Lupien in view of Korpela as applied to claim 11 above discloses at least some of said information comprises information needed by said multimode mobile station to prepare for handover and cell reselection from said GSM system to said UMTS system (Korpela, Page 10, line 12 through Page 13, line 9).

Regarding claim 15, Lupien in view of Korpela as applied to claim 11 above discloses registration procedure is one of Location Updating performed when the multimode mobile station enters the location area, Periodic Location Registration, IMSI attach/detach and Routing Area Update (Lupien, Col. 7, lines 46 – 57).

Regarding claim 16, Lupien in view of Korpela discloses downloading UMTS neighboring cell information for said Location Area to the multimode mobile station (Korpela, Page 10, line 12 through Page 13, line 9).

Regarding claim 18, Lupien in view of Korpela as applied to claim 16 discloses UMTS neighboring cell information includes information about a service capability of UMTS cells (Korpela, Page 10, line 12 through Page 13, line 9).

Regarding claim 19, Lupien in view of Korpela discloses downloading a list of GSM cells that have UMTS neighbors (Korpela, Page 10, line 12 through Page 13, line 9).

Regarding claim 20, Lupien in view of Korpela as applied to claim 16 above discloses additional UMTS neighboring cell information is downloaded to the multimode mobile station upon said mobile station performing Location Updating based on the pre-stored list of GSM cells that have UMTS neighbors (Korpela, Page 10, line 12 through Page 13, line 9).

Regarding claim 21, Lupien in view of Korpela as applied to claim 11 above discloses performing measurements of at least one UMTS neighboring cell in response to said flag (Korpela, Page 10, line 12 through Page 13, line 9).

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Cudak et al. (US 5,862,452).

Regarding claim 14, Lupien as applied to claim 1 above discloses downloading specific information to the mobile station by means of a MM specific procedure (Lupien, Col. 7, lines 34 – 37 and 39 – 45).

However, Lupien as applied to claim 1 above does not specifically disclose at least some of said information comprises frequency and scrambling code combinations for each neighboring cell within said location area each of said frequency and scrambling code combinations being downloaded to said multimode mobile station by means of a multimode (MM) specific procedure. In an analogous art, Cudak discloses downloading frequency hopping table and scramble code index to the peripheral device (Cudak, Col. 45, lines 1 – 4). Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide the technique of Cudak to the system of Lupien in order to provide low complexity dynamic persistence for random access by a peripheral device in a wireless communication system.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Korpela as applied to claim 16 above, and further in view of Cudak et al. (US 5,862,452).

Regarding claim 17, Lupien in view of Korpela as applied to claim 16 above discloses said UMTS neighboring cell information together with intersystem cell reselection parameters for all UMTS neighboring cells within said Location Area (Korpela, Page 10, line 12 through Page 13, line 9).

However, Lupien in view of Korpela as applied to claim 16 above does not specifically disclose frequency and scrambling code combinations. In an analogous art, Cudak discloses downloading frequency hopping table and scramble code index to the peripheral device (Cudak, Col. 45, lines 1 – 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Cudak to the modified system of Lupien and Korpela in order to provide low complexity dynamic persistence for random access by a peripheral device in a wireless communication system.

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10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Korpela as applied to claim 21 above, and further in view of Tiedemann Jr. et al. (US 6,216,004).

Regarding claim 22, Lupien in view of Korpela does not specifically disclose flag is transmitted by means of a BCCH carrier. In an analogous art, Tiedemann discloses said flag is transmitted by means of a BCCH carrier. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Tiedemann to the modified system of Lupien and Korpela in order to provide a need for soft handoff on common channels, such as paging channel, in a cellular system.

Response to Arguments

11. Applicant's arguments with respect to claims 1,2 and 4 – 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

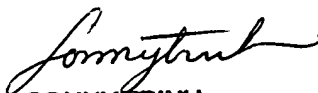
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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C Cho whose telephone number is (703) 305-8725. The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (703) 306-3016. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SONNY TRINH
PRIMARY EXAMINER

Un C Cho 12/27/04 UC
Examiner
Art Unit 2687